

on a separate sheet of paper in compliance with revised 37 CFR 1.121.

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## **B. Claims**

**B1. May I submit a complete claim listing in a reply when I am not making any changes to the claims, such as responding to a restriction requirement or merely arguing a rejection? (posted August 14, 2003)**

Yes. Although a complete claim listing is only required whenever changes are made to any claims, one may be submitted in a reply to an Office action where no changes are being made. It is beneficial to the examiner (and all viewers of the electronic file) to have the most up-to-date set of claims in the most recent paper submitted by the applicant. Note that the claim listing in this situation would not include any claims with markings or any claims with the status identifiers of (new) or (currently amended).

**B2. How should I amend a formula in a claim? (posted August 21, 2003)**

Applicants may use one of the following methods, for example, change "H4" to "H2" in a chemical formula:

(1) Strikethrough and underlining the whole formula.

Claim 1 (currently amended) A curing agent for epoxy resins comprising pyromellitic dianhydride, C6H4 (C2O3)2 C6H2 (C2O3)2.

(2) Doublebrackets and underlining the whole formula.

Claim 1 (currently amended) A curing agent for epoxy resins comprising pyromellitic dianhydride, [[C6H4(C2O3)2]]C6H2 (C2O3)2.

(3) Delete the claim and replace it with a new claim.

Claim 1 (canceled).

Claim 2 (new) A curing agent for epoxy resins comprising pyromellitic dianhydride, C6H2 (C2O3)2.

Do not use strikethrough or doublebrackets to delete only subscript "4" and use underlining to add only subscript "2" in the formula.

**B3. In the past, I have included claim status that indicates how many times a claim has been amended, i.e., "Claim 1 (Twice Amended)." Is it proper to indicate that a claim has been "previously amended twice" or "currently amended for the third time?" (posted August 21, 2003)**

No, under the revised amendment practice, it would NOT be appropriate to indicate how many times a claim has been amended. Only the following seven status identifiers are permitted: "original", "currently amended", "canceled", "new", "withdrawn", "previously presented", and "not entered".

**B4. May I submit a complete claim listing in a reply when I am not making any changes to the claims, such as responding to a restriction requirement or merely arguing a rejection? (posted August 21, 2003)**

Yes. Although a complete claim listing is only required whenever changes are made to any claims, one may be submitted in a reply to an Office action where no changes are being made. It is beneficial to the examiner (and all viewers of the electronic file) to have the most up-to-date set of claims in the

- (4) A claim being canceled must be listed in the claim listing with the status identifier “canceled”; the text of the claim must not be presented. Providing an instruction to cancel is optional.
- (5) Any claims added by amendment must be presented in the claim listing with the status identifier “(new)”; the text of the claim must not be underlined.
- (6) All of the claims in the claim listing must be presented in ascending numerical order. Consecutive canceled, or not entered, claims may be aggregated into one statement (e.g., Claims 1 – 5 (canceled)).

**Example of listing of claims (use of the word “claim” before the claim number is optional):**

Claims 1-5 (canceled)

Claim 6 (previously presented): A bucket with a handle.

Claim 7 (withdrawn): A handle comprising an elongated wire.

Claim 8 (withdrawn): The handle of claim 7 further comprising a plastic grip.

Claim 9 (currently amended): A bucket with a ~~green~~ blue handle.

Claim 10 (original): The bucket of claim 9 wherein the handle is made of wood.

Claim 11 (canceled)

Claim 12 (not entered)

Claim 13 (new): A bucket with plastic sides and bottom.

**B) Amendments to the specification:**

Amendments to the specification, including the abstract, must be made by presenting a replacement paragraph or section or abstract marked up to show changes made relative to the immediate prior version. An accompanying clean version is not required and should not be presented. Newly added paragraphs or sections, including a new abstract (instead of a replacement abstract), must not be underlined. A replacement or new abstract must be submitted on a separate sheet, 37 CFR 1.72. If a substitute specification is being submitted to incorporate extensive amendments, both a clean version (which will be entered) and a marked up version must be submitted as per 37 CFR 1.125.

The changes in any replacement paragraph or section, or substitute specification must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for deletion of five characters or fewer, double brackets may be used (e.g., [leroor]); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number “4” or certain punctuation marks), double brackets must be used (e.g., [4]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., number 4 as number 14 as)

**C) Amendments to drawing figures:**

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment, and may be accompanied by a marked-up copy of one or more of the figures being amended, with annotations. Any replacement drawing sheet must be identified in the top margin as “Replacement Sheet” and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. Any marked-up (annotated) copy showing changes must be labeled “Annotated Marked-up Drawings” and accompany the replacement sheet in the amendment (e.g., as an appendix). The figure or figure number of the amended drawing(s) must not be labeled as “amended.” If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Questions regarding the submission of amendments pursuant to the revised practice set forth in this flyer should be directed to: Elizabeth Dougherty or Gena Jones, Legal Advisors, or Joe Narcavage, Senior Special Projects Examiner, Office of Patent Legal Administration, by e-mail to [patentpractice@uspto.gov](mailto:patentpractice@uspto.gov) or by phone at (703) 305-1616.